

Application No. : **10/773,757**
Filing Date : **February 6, 2004**
Office Action : **May 18, 2007**

REMARKS

This paper is responsive to the May 18, 2007 Office Action and in response to the August 21, 2007 Notice of Non-Compliant Amendment. Claims 1–17 were originally pending in this application. Claims 9–17 were withdrawn from consideration in response to a May 7, 2007 telephonic restriction requirement. Thus, Claims 1–8 were considered in the May 18, 2007 Office Action. Claim 1 is amended herein. Claims 2–8 remain as originally filed. Claims 9–17 are canceled herein. Thus, Claims 1–8 remain pending in this application and are presented herein for further consideration by the Examiner in view of the following remarks.

Confirmation of Election of Claims 1-8 in Response to Restriction Requirement

Applicants confirm the election of Claims 1–8 in response to the May 7, 2007 telephonic restriction requirement. Previously withdrawn Claims 9–17 are canceled herein.

Response to Claim Objections

The Examiner objects to Claim 1 as being informal because the language of the preamble and the body of the claim is inconsistent. The Examiner states that the “plate mounted to a lower end of an end post of a shear wall” sets forth a positive relationship between the plate of the compression post and an end post of the shear wall that appears to be a combination outside the subcombination elected in response to the restriction requirement.

Claim 1 is amended herein to revise the language of the body of the claim to define the compression post as being mountable to an end post to confirm that the claim is directed to the compression post and not to the entire structure. Claim 1 is further amended to remove an inconsistency in the grammar and to improve the readability of Claim 1.

Applicants respectfully request the Examiner to withdraw the formalities objection to Claim 1.

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Response to Claim Rejections under 35 USC § 102 as Being Anticipated by Lopez

The Examiner rejects Claims 1–8 under 35 USC § 102 as being anticipated by US Patent No. 4,480,819 to Lopez. The Examiner asserts that Lopez discloses every limitation of Claims 1–8.

Applicants respectfully disagree with the Examiner's rejection because Lopez neither anticipates nor suggests the limitations of Claims 1–8. Each claim is discussed below.

Claim 1

The Examiner asserts that Lopez discloses:

an attachable device comprising a plate 52 capable of mounting to a lower end of an end post of a shear wall, the plate having dimensions selected to conform to the lower end of the end post.

The Examiner also states that Lopez discloses:

an extended portion 65 positioned generally perpendicular to the plate, the extended portion having at least one dimension selected capable to fit through a hole in a midsill of the shear wall and having a length /s/elected to conform with a thickness of the midsill such that when the shear wall is mounted on the structural support, forces applied to the end post are communicated via the plate and the extended portion to the structural support.

The Examiner further stated that the relation of the compression post with the end post is not given patentable weight because of the election of the subcombination of the compression post.

There is no basis for the Examiner's characterization of the device disclosed in Lopez. The Examiner states that the plate 52 in Lopez is capable of mounting to the lower end of an end post of a shear wall; however, the plate 52 does not provide any suggestion that it could be mounted to the lower end of an end post of the shear wall. The plate 52 does not include any element that enables the plate to be attached to the lower end of an end post. In particular, the surfaces of the plate 52 do not include any openings that allow a screw, a nail or any other type of fastener to secure the plate to the lower end of the end post.

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In order for the second part of the Examiner's rejection regarding the "extended portion" 65 to be understandable, the Examiner must be contending that the plate 52 is mountable to the lower end of the end post with the bottom surface of the plate (the surface showing in Figure 7) against the lower end of the end post. The bottom surface of the plate 52 is obstructed by the lands 95, 96 and by the skirts 53, 54, which prevent the bottom surface of the plate 52 from being mountable to the lower end of the end post. The Examiner does not explain how the plate 52 could be mounted on the obstructed surface. The Examiner may be suggesting that the lands and skirts be removed to allow the plate 52 to be mountable to the lower end of the end post. If so, the Examiner is impermissibly dismantling of the device disclosed by Lopez to create an undisclosed device that would be no longer conform to the device disclosed by Lopez. The Examiner may instead be suggesting that the plate 52 be mounted to the lower end of the end post such that the lower end of the end post is positioned in an area that is obstruction free (e.g., between the skirts 53, 54 and away from the lands 95, 96). If so, the plate 52 must necessarily be larger than the lower end of the end post and thus would not have "dimensions selected to conform to the lower end of the end post."

The Examiner's contentions that the extended portion 65 has "at least one dimension selected capable to fit through a hole in a mudsill of the shear wall" and has "a length selected to conform with a thickness of a mudsill" are also unsupported by Lopez. The "extended portion" 65 in Lopez is disclosed as a machine-threaded nut. The dimensions of the nut are not disclosed in Lopez. More particularly, there is no teaching or suggestion whatsoever that the dimensions of the nut are selected to fit through a hole in a mudsill and that the nut has a length selected to conform to the thickness of the mudsill. The thickness of a mudsill is a known thickness. For example, a conventional 2x4 or 2x6 board used as a mudsill has a thickness of 1.5 inches. In order for the extended portion to be effective, the extended portion must extend approximately 1.5 inches from the plate so that the extended portion extends through the mudsill and rests on the underlying structural support and so that the lower surface of the plate rests on top of the mudsill. Lopez does not suggest that the length or the

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outer dimensions of the nut 65 are selected to conform to the thickness of a mudsill and to fit through a hole in the mudsill.

Applicants also respectfully submit that Lopez is non-analogous art. One skilled in the art of constructing buildings with shear walls would not review art related to the installation of a railing support on the floor grating of an oil rig. Even if a person skilled in the art would stumble across the Lopez patent or a corresponding actual product, there is no basis for the Examiner's contention that the person skilled in the art would be taught to (1) discard the rail post 7 that is screwed into the nut 65, (2) turn the plate 52 over and remove the obstructions on the bottom surface (that is now the top surface), (3) resize the plate to conform to the dimensions of the lower end of the end post, (4) add holes to allow the plate to be fastened to the lower end of the end post, (5) if the nut 65 does not happen to be approximately 1.5 inches in thickness, remove the nut 65 and replace the nut with a nut of the correct thickness (if such a nut is available); and (6) recognize that resulting device could be attached to an end post to prevent the end post from compressing a mudsill during a seismic or severe wind event. Even if Applicants' application were to be impermissibly used as a template, it is highly unlikely that Applicants' invention could be derived from the Lopez disclosure. Without Applicants' application as a guide, it is inconceivable that a person skilled in art would derive Applicants' claimed invention from Lopez.

In view of the foregoing discussion, Applicants respectfully submit that Lopez does not anticipate Claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection under 35 USC § 102(b) based on Lopez. In further view of the foregoing discussion, Applicants respectfully submit that Lopez cannot be used to form the basis for a rejection under 35 USC § 103(a). Thus, Applicants respectfully submit that Claim 1 is patentably distinguished over Lopez.

Claim 2

Claim 2 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Lopez, as discussed above,

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Applicants respectfully submit that Claim 2 is also patentably distinguished over Lopez for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 2 based on Lopez.

Claim 3

Claim 3 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Lopez, as discussed above, Applicants respectfully submit that Claim 3 is also patentably distinguished over Lopez for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 3 based on Lopez.

Claim 4

Claim 4 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Lopez, as discussed above, Applicants respectfully submit that Claim 4 is also patentably distinguished over Lopez for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 4 based on Lopez.

Claim 4 states that "the extended portion is secured to the plate by press fitting an end of the extended portion into a recess in the plate." The Examiner contends that the nut 65 in Lopez is secured to the plate 52 by press fitting an end of the extended portion into a recess 62 in the plate and cites Figure 5 as support for this contention.

Applicants disagree with the Examiner's rejection of Claim 4 because Lopez does not support the Examiner's contention. The aperture 62 is a machine-threaded aperture in the plate 52. As stated in the description of Figures 4 and 5 extending from column 2 at line 66 to column 3 at line 7, the nut 65 is welded to the top surface of the plate 52 in "perfectly coaxial alignment with the aperture 62." There is no suggestion in either the description or in Figures 4 and 5 that any portion of the nut 65 fits into the aperture 62 by press fitting or by any other manner. Accordingly, for at least this additional reason,

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Applicants respectfully request the Examiner to withdraw the rejection of Claim 4 based on Lopez.

Claim 5

Claim 5 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Lopez, as discussed above, Applicants respectfully submit that Claim 5 is also patentably distinguished over Lopez for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 5 based on Lopez.

Claim 5 states that one end of the extended portion is threaded, the plate includes a threaded bore, and the threaded end of the extended portion is engageable with the threaded bore to secure the extended portion to the plate. The Examiner contends that Lopez discloses that the threaded end of the extended portion (the nut 65) is engageable with the threaded bore (the aperture 62) of the plate 52 to secure the nut to the plate.

Applicants respectfully disagree with the Examiner's rejection of Claim 5. As discussed above with respect to Claim 4, the nut 65 is secured to the plate 52 by welding. The inner threads of the nut 65 are aligned with the inner threads of the aperture 62. The inner threads of the nut 65 do not engage the inner threads of the aperture 62. Accordingly, for at least this additional reason, Applicants respectfully request the Examiner to withdraw the rejection of Claim 5 based on Lopez.

Claim 6

Claim 6 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Lopez, as discussed above, Applicants respectfully submit that Claim 6 is also patentably distinguished over Lopez for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 6 based on Lopez.

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Claim 6 further states that the compression post includes an endcap on at least one end of the extended portion and that the endcap has a bore there through. Claim 6 further states that a threaded bore is in the plate. Claim 6 further states that a bolt is sized to extend through the bore of the endcap, and the bolt has a threaded end engageable with the threaded bore in the plate to secure the extended portion to the plate. The Examiner contends that Figures 3, 5 and 6 of Lopez disclose an endcap 3 on at least one end of the extended portion wherein the endcap 3 has a bore 72 there through. The Examiner also contends that a bolt 70 is sized to extend through the bore of the endcap and that the bolt has a threaded end engageable with the threaded bore in the plate to secure the extended portion to the plate.

Applicants respectfully disagree with the Examiner's rejection of Claim 6. Assuming for the sake of argument that the tubular body 3 of the rail post 7 can be considered to be an endcap, the bolt 70 only operates to secure the tubular body to the plate 52 via the threads in the nut 65 and the threads in the aperture 62. The bolt 70 does not secure the nut 65 to the plate 52 because the nut 65 is only secured to the plate 52 by welding as discussed above. Accordingly, for at least this additional reason, Applicants respectfully request the Examiner to withdraw the rejection of Claim 6 based on Lopez.

Claim 7

Claim 7 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Lopez, as discussed above, Applicants respectfully submit that Claim 7 is also patentably distinguished over Lopez for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 7 based on Lopez.

Claim 8

Claim 8 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Lopez, as discussed above,

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Applicants respectfully submit that Claim 8 is also patentably distinguished over Lopez for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 8 based on Lopez.

Claim 8 further states that the extended portion is cylindrical and the at least one dimension is an outside diameter. The Examiner contends that the extended portion 65 is cylindrical and the at least one dimension of the extended portion is an outside diameter.

Applicants respectfully disagree with the Examiner's contention. The outer dimensions of the nut 65 form a hexagonal shape. A hexagonal nut is not cylindrical and does not have an outside diameter. Rather, a hexagonal nut has two outside dimensions. One dimension is the dimension from a flat face to an opposing flat face. The other dimension is from a vertex to an opposing vertex. Neither dimension corresponds to the outside diameter of a cylinder. Accordingly, for at least this additional reason, Applicants respectfully request the Examiner to withdraw the rejection of Claim 8 based on Lopez.

Response to Claim Rejections under 35 USC § 102 as Being Anticipated by Kinney

The Examiner rejects Claims 1, 2 and 4 under 35 USC § 102 as being anticipated by US Patent No. 3,552,698 to Kinney. The Examiner asserts that Kinney discloses every limitation of Claims 1, 2 and 4.

Applicants respectfully disagree with the Examiner's rejection because Kinney neither anticipates nor suggests the limitations in Claims 1, 2 and 4. Each claim is discussed below.

Claim 1

The Examiner asserts that Kinney discloses "a plate 10 capable of mounting to a lower end of an end post of a shear wall, the plate having dimensions selected to conform to the lower end of the end post." The Examiner further states that Kinney

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discloses "an extended portion 14 positioned generally perpendicular to the plate, the extended portion having at least one dimension selected to fit through a hole in a mudsill of the shear wall and having a length [s]elected to conform with a thickness of the mudsill such that when the shear wall is mounted on the structural support, forces applied to the end post are communicated via the plate and the extended portion to the structural support."

Applicants respectfully disagree with the Examiner's rejection because Kinney does not disclose or suggest the features asserted by the Examiner. The plate 10 is not capable of mounting to the lower end of the end post and does not have dimensions selected to conform to the lower end of the end post. Kinney states in column 2 at line 20-21 that "base 10 is of a relatively large area and is secured at a number of space points." The "relatively large area" is not further defined by Kinney; however, there is no suggestion whatsoever that the "relatively large area" of the base 10 is selected to conform to the lower end of an end post of a shear wall. Rather, the area of the base is selected to provide sufficient support for a sign pole that is mounted in the collar 12 and is also selected so that the holes formed in the base can be spaced apart by a sufficient distance to match the spacing of the studs 16 positioned in the roadbed. Such selection criteria based on the required support and on the spacing of studs in a roadbed do not in any manner disclose or suggest dimensions selected to conform to the lower end of an end post of a shear wall of a structure.

The Examiner cites element 14 of Kinney as the extended portion. It is not clear which element 14 the Examiner is citing. Kinney's Figures 1 and 4 and the text identify the pole as element 14 and the collar as element 12, but Kinney's Figure 3 identifies the pole as element 12 and the collar as element 14. The first part of the following discussion assumes that the Examiner is referring to the pole 14 as the extended portion. Applicants also address the collar 12 in case the Examiner is using the element identification in Figure 2.

The pole 14 cannot correspond to the claimed extended portion. Kinney specifically refers to his invention as being directed to traffic light standards, utility and

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other poles that are "plentifully used on, and along the shoulders of, roadways" that are subject to impact from vehicles. [See column 1 at lines 4-10.] Applicants respectfully submit that Kinney discloses no basis for the Examiner's assertion that the pole 14 has a length selected to conform to the thickness of the mudsill (e.g., approximately 1.5 inches). The pole appears in partially broken views in Figures 2 and 4, which illustrate only a portion of the total length of a pole. Although Kinney does not disclose the length of the pole 14, it is unreasonable to contend that the pole has a total length of approximately 1.5 inches.

The collar 12 also does not disclose or suggest the claimed extended portion. Kinney does not disclose specific dimensions for the collar 12; however, Kinney states that the collar 12 receives the lower end of a pole 14. Accordingly, the dimensions of the collar 12 must be selected to conform to the requirements for supporting the pole. The inside diameter of the collar is selected to receive the pole. The height of the collar is likely selected to provide sufficient lateral support for the pole. Neither the diameter of the collar nor the length of the collar is selected with regard to the dimensions of a mudsill. In particular, Kinney does not suggest that the length of the collar is selected to be 1.5 inches to conform to the thickness of a conventional mudsill. Kinney also does not suggest that the outer diameter of the collar is sized to fit within the boundaries of the mudsill. Rather, the dimensions in Kinney are determined by the size of the pole that the device supports. Applicants' claimed selected dimensions can only be obtained by impermissibly using the present application as a template to modify a structure from a totally unrelated field to create a structure in accordance with the claimed invention.

Even if the dimensions of the Kinney device were modified to conform to the claimed invention, Kinney's base plate 10 is not capable of mounting to the lower end of an end post of a shear wall. The base plate 10 has four holes. Each hole receives a respective bolt 36. Each bolt is secured on the top face by a washer 42 and a nut 44 and is secured on the bottom face by head 46 of the bolt and by washers 38 and 40 on either side of the coupling housing 24. Such a mounting scheme could not be used to mount the base plate 10 to the lower end of the end post since the end post does not

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include the studs 16 to engage the coupling housings 24. Furthermore, the extended portion of the bolt 36 and the nut 44 would preclude the surface of the plate 10 from resting on the mudsill. Thus, the length of the collar 12 could not have a length selected to conform to the thickness of the mudsill. Because of the offset caused by the protruding bolt and nut, the claimed length would not be sufficient to enable the end of the collar to rest on the structural support underlying the mudsill so that forces applied to the end post would be communicated by the plate and the extended portion to the structural support as specified in Claim 1.

In summary, the Kinney disclosure does not anticipate Claim 1. Furthermore, the Kinney disclosure does not render Claim 1 obvious. One skilled in the art of building construction would not be presumed to have knowledge of traffic pole supports. Even if a person skilled in the art of building construction were to have knowledge of the disclosure in Kinney, the Kinney disclosure provides no suggestion to that skilled person that the disclosed structure could be modified to conform to the claimed dimensional requirements and that the modified structure could be mounted on the lower end of an end post of a shear wall to communicate forces applied to the end post through the plate and the extended portion to the structural support underlying the mudsill.

In view of the foregoing, Applicants respectfully submit that Claim 1 is patentably distinguished over Kinney. Applicants respectfully request the Examiner to withdraw the rejection of Claim 1 based on Kinney.

Claim 2

Claim 2 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Kinney, as discussed above, Applicants respectfully submit that Claim 2 is also patentably distinguished over Kinney for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 2 based on Kinney.

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Claim 4

Claim 4 depends from Claim 1 and further defines the invention defined in Claim 1. In view of the patentability of Claim 1 over Kinney, as discussed above, Applicants respectfully submit that Claim 4 is also patentably distinguished over Kinney for at least the foregoing reasons. Applicants respectfully request the Examiner to withdraw the rejection of Claim 4 based on Kinney.

Claim 4 states that “the extended portion is secured to the plate by press fitting an end of the extended portion into a recess in the plate.” The Examiner contends that Claim 4 is anticipated by Kinney because “the extended portion 14 is secured to the plate by press fitting an end of the extended portion into a recess 12 in the plate (Fig. 2).” Apparently, the Examiner is identifying the pole 14 of Figures 1 and 4 as the extended portion and is identifying the collar 12 as the recess in the plate.

Applicants respectfully submit that the rejection of Claim 4 based on the insertion of the pole 14 into the collar 12 is not supported by the Kinney disclosure. As discussed above with respect to Claim 1, the pole 14 does not correspond to the claimed extended portion. Furthermore, the pole 14 is not press fit into a recess in the base 10. As noted by the Examiner, the pole 14 is inserted into the collar 12. The collar 12 is not a recess in the base 10. Rather, the collar 12 is a protrusion from the base 10. There is no basis for the Examiner’s mischaracterization of the protruding collar 12 as a “recess.” Accordingly, the rejection of Claim 4 based on Kinney is not supported by Kinney and must be withdrawn for at least this additional reason.

Applicants also respectfully submit that the pole 14 of Kinney is not press fit into the collar 12. In column 1 at lines 58–60, Kinney states:

The pole may have a tight fit in collar 12 or it may be secured thereto.

Kinney does not suggest that the pole 14 is press fit into the collar 12. The term “press fit” has a meaning that does not correspond to “tight fit.” The pole 14 in Kinney may have a tight fit with respect to the surrounding collar 12; however, a “tight fit” simply means that the inside diameter of the collar 12 and the outside diameter of the pole 14

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are closely matched so that the pole does not move within the collar 12. On the other hand, if the two components in Kinney were "press fit" together, the dimensions of the inside diameter of the collar 12 and the outside diameter of the pole 14 would have to be selected so that the outside diameter of the pole 14 is slightly larger than the inside diameter of the collar 12. Considerable force is required to engage two components to produce a press fit connection. Kinney does not suggest that the term "tight fit" means "press fit." It is not likely that the poles would be "press fit" into the collar at the worksite because of the pressure required. Furthermore, the Kinney system is intended to break away when a vehicle impacts the pole. It is likely that the pole would have to be replaced after an impact. Press fitting the pole into the collar likely would require the base plate to be discarded with the pole because press-fit connections are difficult to disassemble. Since Kinney is silent on this aspect of the disclosed device, there is no basis for the Examiner's assertion that Kinney discloses a press fit connection of any parts.

Accordingly, for at least the foregoing additional reasons, Applicants respectfully request the Examiner to withdraw the rejection of Claim 4 based on Kinney.

Summary of Response

Applicants have withdrawn Claims 9–17. Applicants have amended Claim 1 in response to the formalities rejection. Applicants have presented arguments to show that the Examiner's rejections of Claims 1–8 based on Lopez and the Examiner's rejections of Claims 1, 2 and 4 based on Kinney are not supported by the cited references. Accordingly, Applicants respectfully submit that amended Claim 1 and original Claims 2–8 are patentably distinguished over the cited references and are in condition for immediate allowance.

Applicants respectfully request the Examiner to withdraw all objections and rejections to Claims 1–8 and to pass this application to the issue process.

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Request for Interview

Applicants respectfully request the Examiner to contact Applicants' undersigned attorney of record to resolve any issues that may remain after the Examiner fully considers this response. If only minor issues remain to be resolved after entry of this response, the Examiner is cordially invited to call the undersigned attorney at 949-433-2849 to resolve any such issues or to allow the undersigned attorney to schedule a personal interview with the Examiner.

Respectfully submitted,

Dated: August 23, 2007

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